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MAR 24 2005

In re Application of	:	OFFICE OF PETITIONS
Van Dijk et al.	:	
Application No. 09/171,910	:	DECISION
International Filing Date:	:	ON PETITION
April 27, 1995	:	
371 Date: March 18, 1999	:	
Title of Invention: PLASTIC-BASED	:	
COMPOSITE PRODUCT AND METHOD AND	:	
APPARATUS FOR MANUFACTURING SAME	:	

This is a decision in response to the Request for reconsideration of the decision on Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed January 12, 2005.

This Petition is hereby granted.

Background

Applicant filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on July 11, 2002 and a second RCE on November 24, 2003 in the above-identified application, which is the National Stage of an International Application filed on April 27, 1995. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e) (3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure (MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on March 14, 2002. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on July 11, 2002 did not toll the time period set forth in the Office action mailed on March 14, 2002. Thus, the application became **abandoned on July 16, 2002** for the failure to reply to the Office action mailed on March 14, 2002.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A non-final Office action was mailed on October 4, 2002. An Amendment was filed on January 6, 2003. A final Office action was mailed on March 25, 2003. A Notice of Appeal and an Amendment, along with an extension of time were filed on September 26, 2003. An Advisory Action was mailed on October 28, 2003. A second improper RCE was filed on November 24, 2003. A Notice of Allowance and Notice of Allowability were mailed on February 11, 2004.

Applicant was advised in a Notice Regarding Improper RCE, mailed July 26, 2004, the RCE was improper, and advised to file a petition under 37 CFR 1.137(b) and a terminal disclaimer and fee as set forth in 37 CFR 1.321 because the application was filed before June 8, 1995.

Applicant filed a petition to revive the application based upon unintentional abandonment of the application on August 30, 2004. The petition was dismissed in a Decision mailed December 9, 2004, for failing to meet the requirements of a grantable petition under 37 CFR 1.137(b).

Discussion

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional", and (4) a terminal disclaimer (and fee set forth in § 120(d)) is required pursuant

to paragraph (c) of this section (for applications filed before June 8, 1995).

Applicant has satisfied Items (1) through (4). With regard to subsection (4), since the above-identified application is a utility application filed before June 8, 1995, 37 CFR 1.137(c) requires a terminal disclaimer dedicating to the public a terminal part of any term of any patent granted on the above-identified application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. The period to be disclaimed will be a terminal part of the patent to be granted equivalent to the period of abandonment. The period of abandonment will be computed to be the number of months lapsed from the date of abandonment to the date when this application issued as a patent. A Terminal disclaimer fee of \$110 is required and has been provided. The Terminal Disclaimer filed on January 12, 2005 has been accepted.

All of the requirements of 37 CFR 1.137(b) have now been met. Accordingly, applicant's petition to revive is granted.

The application is being referred to publications branch for processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.



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Attorney/Advisor
Office of Petitions